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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
| 09/437,352 | 11/09/1999 | DIMITRI KANEVSKY | YO999-411 | 7851 |
| 7590 | 12/06/2004 | | EXAMINER | |
| KEVIN M MASON RYAN MASON & LEWIS LLP 1300 POST ROAD SUITE 205 FAIRFIELD, CT 06430 | | | STULBERGER, CAS P | |
| | | | ART UNIT | PAPER NUMBER |
| | | | 2132 | |
| | | | DATE MAILED: 12/06/2004 | |

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | | |
|------------------------------|------------------------|---------------------|--|
| Office Action Summary | Application No. | Applicant(s) | |
| | 09/437,352 | KANEVSKY ET AL. | |
| | Examiner | Art Unit | |
| | Cas Stulberger | 2132 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) Responsive to communication(s) filed on 01 July 2004.

2a) This action is **FINAL**. 2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) Claim(s) 1-58 is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5) Claim(s) _____ is/are allowed.

6) Claim(s) 1-58 is/are rejected.

7) Claim(s) _____ is/are objected to.

8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All b) Some * c) None of:

- Certified copies of the priority documents have been received.
- Certified copies of the priority documents have been received in Application No. _____.
- Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) Notice of References Cited (PTO-892)

2) Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____

4) Interview Summary (PTO-413)
Paper No(s)/Mail Date _____

5) Notice of Informal Patent Application (PTO-152)

6) Other: _____

DETAILED ACTION

1. This action is responsive to communications: application, filed 11/09/1999; amendment filed 07/01/2004.
2. Claims 1-58 are pending in the case. Claims 1, 16, 27, 38, 39, 42, 45, 49, 52, and 56 are independent claims.

Response to Arguments

3. Applicant's arguments filed 07/01/2004 have been fully considered but they are not persuasive.
4. Applicant argues that "MacDoran compares the expected location of an electronic device with the current location of the device and will not allow access if the locations do not match. The present invention, alternatively, is directed to authenticating a user by confirming the location of the user utilizing, for example, a GPS device carried by the user. Thus MacDoran would require a single GPS device located at a client machine and the present invention would require, for example, a separate GPS device for each user of the client machine." MacDoran however discloses that the LSS device, whose function is to produce digitized state vectors, may exist in a PCMCIA card format for laptop computers for use in remote clients or mobile host server applications. It can also be configured into a single microchip for integration into original equipment manufactured products (MacDoran: column 15, lines 43-47, 58-59). This allows each user to have a separate GPS device.

5. Applicant also argues that "MacDoren defines 'entity' as an electronic device and specifically states that this definition 'does not extend to individual users that operate an entity, because the invention does not have the ability to authenticate an individual person' (MacDoren: column 6, lines 59-65)." MacDoren however discloses authentication a user or device by using various methods such as passwords, PIN's, smart cards, PCMCIA cards, and biometric authentication (MacDoren: column 1, lines 21-55). This meets the limitation of authenticating an individual person.

6. According to MPEP Section 2123 "The use of patents as references is not limited to what the patentees describe as their own inventions or to the problems with which they are concerned. They are part of the literature of the art, relevant for all they contain." In re Heck, 699 F.2d 1331, 1332-33, 216 USPQ 1038, 1039 (Fed. Cir. 1983) (quoting In re Lemelson, 397 F.2d 1006, 1009, 158 USPQ 275, 277 (CCPA 1968)).

A reference may be relied upon for all that it would have reasonably suggested to one having ordinary skill the art, including nonpreferred embodiments. Merck & Co. v. Biocraft Laboratories, 874 F.2d 804, 10 USPQ2d 1843 (Fed. Cir.), cert. denied, 493 U.S. 975 (1989). See also Celeritas Technologies Ltd. v. Rockwell International Corp., 150 F.3d 1354, 1361, 47 USPQ2d 1516, 1522-23 (Fed. Cir. 1998) (The court held that the prior art anticipated the claims even though it taught away from the claimed invention. "The fact that a modem with a single carrier data signal is shown to be less than optimal does not vitiate the fact that it is disclosed.").

Disclosed examples and preferred embodiments do not constitute a teaching away from a broader disclosure or nonpreferred embodiments. In re Susi, 440 F.2d 442, 169 USPQ 423 (CCPA 1971). "A known or obvious composition does not become patentable simply because it

has been described as somewhat inferior to some other product for the same use." *In re Gurley*, 27 F.3d 551, 554, 31 USPQ2d 1130, 1132 (Fed. Cir. 1994) (The invention was directed to an epoxy impregnated fiber-reinforced printed circuit material. The applied prior art reference taught a printed circuit material similar to that of the claims but impregnated with polyester-imide resin instead of epoxy. The reference, however, disclosed that epoxy was known for this use, but that epoxy impregnated circuit boards have "relatively acceptable dimensional stability" and "some degree of flexibility," but are inferior to circuit boards impregnated with polyester-imide resins. The court upheld the rejection concluding that applicant's argument that the reference teaches away from using epoxy was insufficient to overcome the rejection since "Gurley asserted no discovery beyond what was known in the art." 27 F.3d at 554, 31 USPQ2d at 1132.)"

Since MacDoren discloses that "the definition does not extend to individual users that operate an entity, because the invention does not have the ability to authenticate an individual person" (MacDoren: column 6, lines 59-65) this does not mean that creating a system that can authenticate an individual user is therefore not taught by MacDoren.

7. Applicant argues that MacDoren does not disclose "identifying each registered person within a predefined distance of said requested device." MacDoren discloses the host authentication server produces a remote client location that matches the previously registered client location within a predetermined threshold, such as 3 meters, access is granted to the remote client user (MacDoren: column 24, lines 18-29).

8. Applicant argues that MacDoren does not disclose “identifying said user by comparing a location of each identified potential users with a location where said biometric information was obtained.” MacDoren discloses using biometric authentication as a means to authenticate a user (MacDoren: column 1, lines 21-27, 50-55). MacDoren also discloses comparing the location of the client with the location stored in the database (MacDoren: column 24, lines 14-16).

9. Applicant argues that MacDoren does not disclose “identifying said user and confirming said user requesting access to said device is physically present at the location of said requested device by determining a location of said transmitting devices (wherein said transmitting device is associated with said user).” MacDoren discloses using biometric authentication such as finger and thumb prints, hand geometry, voice prints, retinal scans, and keystroke patterns (MacDoren: column 1, lines 50-55). In order to biometrically authenticate the user has to be present at the location of the transmitting device or else it would be impossible to accomplish any of the previously described biometric authentication techniques.

10. Applicant argues that Meyer does not disclose “the identification of a user as described in the limitations of the independent claims.” Meyer discloses “using 911 techniques or querying the user about something at the location of a requested device or facility.” Li in view of MacDoren is used to reject the independent claims. See previous action below for further clarification.

11. In view of the rejections and response to arguments above, the prior art rejections are maintained. The grounds of rejection as set forth in the previous office action is reproduced below.

Claim Rejections - 35 USC § 103

12. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

13. Claims 1-11, 13, 15-21, 24, 26-32, 35, 37-39, 40-47, 49, and 50-57 above are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,219,793 B1 to Li et al. and further in view of U.S. Patent No. 5,757,916 to MacDoran et al.

14. In regards to claims 1, 5, 15-16, 26, 27, 37-39, 40-47, 49, and 50-57, Li discloses a system and a method for employing a user's fingerprint to authenticate a wireless communication. When a wireless communication is to be initiated, the central authentication system engages in a challenge-response authentication with the wireless phone using the stored fingerprint associated with the mobile identification number (MIN) (Li: Abstract). Li also discloses that biometric data other than fingerprints can be used such as a user's voice (Li: column 17, lines 29-35).

However Li does not disclose a challenge response method that uses the location.

MacDoran discloses that the state vector attributes distilled from the state vector observations supplied to the host authentication server define the location of the client, and that

location is compared to the particular predefined location information for that client stored in the database. If the host authentication server produces a remote client location that matches the previously registered client location within a predetermined threshold, access is granted to the remote client user (MacDoran: column 24, lines 12-15).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to combine the method of using biometric data to authenticate wireless communications as disclosed by Li with the method of providing the location of the client and compared it to the stored location value and granting access to the user if the location is within a predetermined threshold as disclosed by MacDoran in order to make “spoofing” the host device very difficult (MacDoran: column 1, lines 15-16).

15. In regards to claim 2, Li discloses requesting a personal identification number (PIN) each time a call is made. This meets the limitation of a “password.”

16. In regards to claims 3, 4, 10, 21, 32, Li does not disclose a pocket token or computer readable card.

MacDoran discloses using access tokens (MacDoran: column 1, lines 40, 49). This meets the limitation of “wherein said response is a computer readable card” or “pocket token.”

It would have been obvious to one having ordinary skill in the art at the time the invention was made to combine the wireless cellular phone as disclosed by Li with the method of using access tokens as disclosed by MacDoran in order to determine whether a person or device attempting to access or perform a transaction with a host computer system is a person or device

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entitled to access, most host computer systems require the person or device to provide information confirming identity (MacDoran: column 1, lines 21-25).

17. In regards to claims 6-9, 11, 13, 17-20, 24, 28-31, and 35, Li does not however disclose using a global positioning system.

MacDoran discloses using a Global Position System (GPS) sensor to determine the location of the singnature provided by the remote client. This meets the limitation of "wherein said global positioning system includes a local verification system."

It would have been obvious to one having ordinary skill in the art at the time the invention was made to combine the wireless cellular phone as disclosed by Li with the global positioning system as disclose by MacDoran in order to determine the location of an object or person with great precision and accuracy (MacDoran: column 5, lines 41-43).

18. Claims 12, 14, 22, 23, 25, 33, 34, 36, 48, and 58 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,219,793 B1 to Li et al. in view of U.S. Patent No. 5,757,916 to MacDoran et al applied to claims 1-11, 13, 15-21, 24, 26-32, 35, 37-39, 40-47, 49, and 50-57 above, and further in view of "Wireless Enhanced 9-1-1 Service - Making it a Reality," Bell Labs Technical Journal (Autumn 1996) by Meyer et al.

In regards to claims 12, 14, 23, 25, 34, 36, 48, and 58, Li does not disclose using 911 techniques or querying the user about something at the location of a requested device or facility.

Meyer however discloses asking the user of the cell phone "Do you have any more details on your location?" (Meyer: page 189, right column, lines 1-2).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to combine the wireless cellular phone as disclosed by Li with the method of querying the user as to where they are because the existing E9-1-1 service was originally designed to support wireline calls from fixed locations (Meyer: page 188, right column, second paragraph).

19. In regards to claims 22 and 33 Li does not however disclose using triangulation. Meyer however discloses that triangulation methods can be used (Meyer: page 198, left column).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to combine the wireless cellular phone as disclosed by Li with the method of using triangulation as disclosed by Meyer because it can be implemented at a relatively low additional cost (Meyer: page 196, right column, third paragraph, last line).

Conclusion

20. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cas Stulberger whose telephone number is (703) 305-8034. The examiner can normally be reached on Monday - Friday, 9:00A.M. - 5:00P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gilberto Barron can be reached on (703) 305-1830. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

CS

CS

THOMAS R. PEESO
PRIMARY EXAMINER